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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/282,450	03/31/99	KAWAI	H 990295
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EXAMINER

LEE, D

ART UNIT

PAPER NUMBER

2876

DATE MAILED: 07/31/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
**09/282,450**

Applicant(s)  
**KAWAI et al.**

Examiner  
**Diane Lee**

Art Unit  
**2876**



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on May 31, 2001
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 9-12 is/are rejected.
- 7) ☒ Claim(s) 8 is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some\* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

### DETAILED ACTION

1. The request filed on 31 May 2001 for a Request for continued Examination (RCE) under 37 CFR 1.114 based on the Application No. 09/282,450 is acceptable and a RCE has been established. An action on the RCE follows.

2. Receipt is acknowledged of the Amendment filed 31 May 2001. Claims 1-2 and 9 have been amended and claims 10-12 have been newly added. Currently claims 1-12 are pending in this application.

#### *Claim Objections*

3. Claims 5, 7-8, and 10-12 are objected to because of the following informalities:

(a) Re claim 5, line 3: "the entire" should be changed to --an entire--;

(b) Re claim 7, line 3: "the entire" should be changed to --an entire--;

(c) Re claim 7, line 6: "it" should be changed to --said detection result--;

(d) Re claim 7, line 8: "the effect" should be changed to --an effect--;

(e) Re claim 8, line 3: "The period" should be changed to --a period--;

(f) Re claim 10, line 2: "plate-like" should be changed to --plate--;

(g) Re claim 11, line 2: "plate-like" should be changed to --plate--; and

(h) Re claim 12, line 2: "plate-like" should be changed to --plate--.

Appropriate correction is required.

#### *Claim Rejections - 35 USC § 102*

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

1 A person shall be entitled to a patent unless --

2 (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this  
3 country, more than one year prior to the date of application for patent in the United States.

4 5. Claims 1-4 and 10-11 are rejected under 35 U.S.C. 102(b) as being anticipated by Minasy et al. [US  
5 4,684,930-referred as Minasy].

6 Minasy discloses a commodity information management system (supermarket checkout counter 10)  
7 for managing a commodity as well as security thereof based on a bar code and a tag (target 30) attached to the  
8 commodity (merchandise 14) (see the abstract, col. 3, lines 30+, col. 4, lines 38+, and figures 1-2), the system  
9 comprising:

10 a bar code reader 40 for reading the bar code (see col. 4, lines 38+ and figure 1);

11 a deactivator (a target deactivator 42, 44) provided downstream from the reader (just beyond the bar  
12 code reader on the checkout counter) for deactivating the tag after the bar code is read by the reader (see col.  
13 4, lines 54+);

14 a magnetic detector (a pair of spaced apart antenna 20, 22 in the interrogating zone 24 which leads to  
15 the store exit) provided downstream from said deactivator (the antenna in the interrogating zone located  
16 beyond the counter) for detecting affectivity of the tag, i.e., magnetic field of the tag (see col. 3, lines 42-col.  
17 4, lines 16 and figure 1);

18 a notifying unit (a light 28 and/or an audible alarm) for notifying an operator of a detection result by  
19 the detector (i.e., by producing an alarm such a light 28 or an audible alarm) (see col. 3, lines 53+ and figure  
20 1);

21 Minasy teaches that the tag that is attached to the commodity having a thin elongated strip of  
22 saturable material (see col. 4, lines 17+). As the commodity is place on the counter and carried by the  
23 conveyor belt 12 in the direction indicated by an arrow A toward the cash register 16 positioned along side of

1 the counter, the commodity is passed over the bar code reader and tag deactivator. The commodity is carried  
2 though the interrogation zone of the exit passageway to detect the affectivity of the tag by the detector, and  
3 the notifying unit is activated only when the tag is still activated. Since the tag provides a security measure  
4 against shoplifting in the store, the tag clearly performs the function of security management at an exit of the  
5 store.

6 Re claims 10-11: wherein the tag is made of a magnetic material formed in a thin plate (see col. 4,  
7 lines 17-24 and figure 2)

8  
9 *Claim Rejections - 35 USC § 103*

10 6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections  
11 set forth in this Office action:

12 (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this  
13 title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a  
14 whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said  
15 subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16 This application currently names joint inventors. In considering patentability of the claims under 35  
17 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at  
18 the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised  
19 of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not  
20 commonly owned at the time a later invention was made in order for the examiner to consider the  
21 applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

22 7. Claims 9 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Minasy. The  
23 teachings of Minasy have been discussed above.

1 Minasy is silent with respect to the specifics of an output unit for outputting a deactivating section-  
2 drive signal for driving a deactivating section which deactivates a security tag attached to the commodity.

3 Minasy teaches that the commodity is carried toward the tag deactivator by the conveyor belt and/or  
4 by the operator when the bar code reader reads the bar code data. The deactivator causes the tag to become  
5 deactivated so that commodity can be carried through the detector without producing an alarm (see col. 4, line  
6 54-col. 5, line 4). He also states that the deactivator includes a deactivator cylinder 44 with a plurality of  
7 permanent magnets 45 arranged with their poles near the surface of the deactivator so as to produce a pattern  
8 of oppositely directed magnetic fields (see col. 5, lines 30+ and figures 4-5).

9 It would have been obvious to an artisan of ordinary skill in the art at the time the invention was  
10 made to recognize that a plurality of permanent magnets which produce a pattern of oppositely directed  
11 magnetic fields is functionally equivalent to an output unit outputting a deactivating section-drive signal for  
12 driving a deactivating section for the purpose of deactivating the tag of the commodity so that the detecting  
13 unit will not activate the alarm mechanism. Accordingly, such modification would have provided Minasy  
14 with an additional means for preventing a false alarm, and therefore, it would have been an obvious  
15 expedient.

16  
17 8. Claims 5-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Minasy in view of  
18 Ruppert et al. [US 5,640,002-referred as Ruppert]. The teachings of Minasy have been discussed above.

19 Re claims 5-6: Although the detector and the notifying unit of Minasy provides the claimed function  
20 of the control unit for making a visual and/or an audible report (i.e., notifying the detection result by  
21 outputting a signal to activate/inactivate the alarm mechanism) to the effect that the security is not released  
22 (i.e., the tag is still activated), Minasy does not disclose the system having a host terminal for controlling the

1 operation of the entire system and a reporting unit for reporting the result of detection to the host terminal as  
2 an electronic data.

3 Ruppert discloses a commodity information management system for managing commodities (e.g.,  
4 supermarket products 500, 504) based on a bar code 506 and a magnetized security tag 507 affixed to the  
5 product (see col. 32, lines 1+ and figure 27). The system includes:

6 a deactivating unit 518 for deactivating the security tag (see col. 36, lines 24+ and figure 30);

7 a detector 516 having a determining unit 538 for determining whether or not security tag has been  
8 deactivated according to the detection result (see col. 36, lines 18 and figure 31);

9 a host terminal 509 in communication with the check out terminal 501, the deactivator, and the  
10 detector for controlling operation of the entire check out system such as monitoring and managing the  
11 transaction process including validation, deactivating, updating, and etc. (see figures 27+); and

12 wherein the detection notifies the detection result by setting the alarm and transmitting the signal  
13 (i.e., electronic data) to the host terminal via signal line 524 (see figure 27).

14 In view of Ruppert's teaching, it would have been obvious to an artisan of ordinary skill in the art at  
15 the time the invention was made to incorporate the conventional host terminal and its security management  
16 function in the system of Minasy in order to provide a system that has a control manager that monitors and  
17 controls the entire transaction process and to improve the security measures of the merchandise in the store  
18 from theft or the like. Therefore, such modification would have enhanced the inventory control and tracking  
19 operation of an entire store.

20 Re claim 7: Minasy does not disclose a control unit for making a report when it is determined that the  
21 tag has not been deactivated to the effect that the security is not released to the host terminal, and also  
22 sending a notice to the effect a retry of checking deactivation of the tag is requested to the operator.

10. The following is a statement of reasons for the indication of allowable subject matter: the best prior art of the record, Minasy and Ruppert, taken alone or in combination, fails to specifically teach or fairly suggest the control unit enables only the function of the detector during the period of time until the determining unit determines that the security tag is deactivated when a retry of checking deactivation of the tag is request, as set forth in the claim.



*Response to Arguments*

11. Applicant's arguments with respect to claim 1 have been considered but are moot in view of the new ground(s) of rejection.

*Conclusion*

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Yerbury [WO 87/04282], Montbriand et al. [US 5,410,296], and Joseph [US 5,635,906] discloses a security tag in an inventory control system.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to *Diane I. Lee* whose telephone number is (703) 306-3427. The examiner can normally be reached between the hours of 7:00AM to 4:30PM Monday thru Thursday and every other Friday (first Friday of the bi-week).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Lee, can be reached on (703) 305-3503. The fax phone number for this Group is (703) 308-7722.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [michael.lee@uspto.gov].

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Serial Number: 09/282,450  
Art Unit: 2876

Applicant(s): KAWAI et al. (235/462.13)  
Representative: William L. Brooks (Reg. No. 34,129)

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1           Any inquiry of a general nature or relating to the status of this application or proceeding should be  
2 directed to the Group receptionist whose telephone number is (703) 308-0956.

3  
4  
5 

6 **Diane I. Lee**  
7 **Art Unit 2876**  
8 **July 27, 2001**